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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,632	02/16/2001	Jin-Soo Kim	12279-002001	3563

7590

07/02/2002

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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 07/02/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,632

Applicant(s)

KIM ET AL.

Examiner

Terry Mckelvey

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-85 are subject to restriction and/or election requirement.

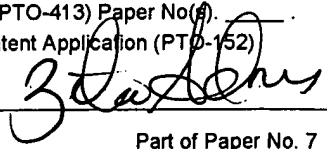
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: 

Art Unit: 1636

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 21-23, and 32-33, drawn to method of identifying a zinc finger domain that recognizes a target site, classified in class 435, subclass 6.
- II. Claims 16-20, drawn to method of identifying a zinc finger domain that recognizes a target site, classified in class 435, subclass 6.
- III. Claims 24-25 and 34-35, drawn to method of identifying a zinc finger domain that recognizes a target site, classified in class 435, subclass 6.
- IV. Claims 26-31, drawn to method of determining whether a test zinc finger recognizes a target site on a promoter, classified in class 435, subclass 6.
- 5-54. Claims 36-85, respectively, drawn to purified polypeptide comprising a specific sequence (even number claims) and nucleic acid comprising a sequence encoding a polypeptide of a specific sequence (odd number claims), classified in class 530, subclass 350 and class 536, subclass 23.1.

Art Unit: 1636

The inventions are distinct, each from the other because of the following reasons:

Groups 5-54 are individually drawn to polypeptide or nucleic acid drawn to different and distinct sequences which are chemically, biologically, functionally, and structurally different and distinct from each other and thus do not render obvious each other and thus are patentably distinct. Note, this restriction to examination of a single sequence is due to the now very high and undue burden for examining more than one sequence which is caused by the continued exponential increase of size of the sequence databases to be searched for each sequence, resulting in a corresponding increase in computer search time and examiner time for reviewing the computer search results. Therefore, the limited resources of the Office no longer permit examination of more than one sequence in an application.

Inventions of Groups I-IV are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups I-III, although all drawn to the same general goal of identifying a zinc finger domain that recognizes a target site on a DNA, all perform different sets of method steps to achieve that goal based upon different approaches using different method steps to ultimately

Art Unit: 1636

achieve the goal. For example, Group I provides a plurality of hybrid nucleic acids to a cell, Group II amplifies a plurality of nucleic acid sequences each of which encodes a test zinc finger domain, and Group III fuses two different cells in the assay. Group IV, drawn to a different and distinct method with a different and distinct goal, provides a plurality of reporter constructs each with a different test target site for the test zinc finger domain. The end result of the methods are different: the different method steps of Groups I-III achieve different sets of zinc finger domains and Group IV determined whether a test zinc finger domain recognizes a target site on a promoter. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Inventions of Groups 5-54 and Groups I-IV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product can be practiced with a materially

Art Unit: 1636

different product, any test zinc finger domain, which are patentably distinct from each other as evidenced by the Groups of 5-54 or, one not listed. Also, the product as claimed can be used in a materially different process as evidenced by the distinct inventions of Groups I-IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for the different groups classified in the same class/subclass require a separate non-patent literature search drawn to either different method steps present in the other groups, or different sequence, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1636

Conclusion

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning missing attachments or other minor formalities of this communication should be directed to the patent analyst, Zeta Adams, whose telephone number is (703) 305-3291.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached at (703) 305-1998.

Art Unit: 1636

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.
Primary Examiner
Art Unit 1636

July 1, 2002